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EXAMINER

WASSUM, LUKE S

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN M. HITCHEN and PAUL BATTERSBY

Appeal 2008-1218
Application 09/992,582
Technology Center 2100

Decided: October 29, 2008

Before JEAN R. HOMERE, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm in part.

THE INVENTION

The disclosed invention relates generally to file security and digital rights management. More particularly, the invention is directed to methods and systems for transparently protecting, controlling and managing files in a collaborative environment. (Spec. 1, ll. 1-4).

Independent claim 1 is illustrative:

1. A collaborative file rights management method comprising:
 - identifying a file input/output (I/O) request to access a file, said file I/O request originating in an authoring application;
 - suppressing said file I/O request;
 - automatically extracting digital rights management data appended to said file;
 - providing said file to said authoring application; and
 - managing access to said file in said authoring application based upon said extracted digital rights management data.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejections:

Morinaga	US 5,724,578	Mar. 3, 1998
McCurdy	US 2002/0035697 A1	Mar. 21, 2002 (filed Jul. 2, 2001)
Graham	US 2002/0178271 A1	Nov. 28, 2002 (filed Nov. 20, 2001)

THE REJECTION

1. Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Morinaga in view of McCurdy and Graham.

APPELLANTS' CONTENTIONS

1. Appellants contend that the Examiner erred in rejecting claims 1-20 as being unpatentable over Morinaga, McCurdy, and Graham because the cited references, most notably Graham, fail to teach or suggest suppression of a file I/O request. (App. Br. 4). Appellants further contend that the cited references fail to teach or suggest the extraction of digital rights after suppressing the file I/O requests. (Reply Br. 3)

2. Appellants contend that the Examiner erred in rejecting claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Morinaga, McCurdy and Graham because one skilled in the art would not have been motivated to combine the teachings of Morinaga and Graham. (App. Br. 6).

EXAMINER'S FINDINGS

1. The Examiner determined that Graham teaches a client module 230 that intercepts and modifies the file requests. (Ans. 12-14).
2. Regarding the motivation to combine Morinaga and McCurdy with the tertiary Graham reference, the Examiner found that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to intercept and suppress file I/O requests in order to implement usage management, since this allows clients to access and

utilize files without changing the process for accessing files in any way from the user's perspective, i.e., users continue to use Network Neighborhood or content management software, and other standard applications to access remote storage drives and directories (see paragraphs [0138] and [0139]).” (Ans. 6).

ISSUES

1. Whether Appellants have shown that the Examiner failed to establish that the cited references teach or suggest suppression of a file I/O request, as recited in claim 1?
2. Whether Appellants have shown that the Examiner has failed to establish a proper motivation for one skilled in the art to combine the teachings of Graham with Morinaga?

PRINCIPLES OF LAW

Obviousness

In rejecting claims under 35 U.S.C. § 103, “[w]hat matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

The reasoning given as support for the conclusion of obviousness can be based on “interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and

the background knowledge possessed by a person having ordinary skill in the art.” *KSR*, 127 S. Ct. at 1740-41.

We note our reviewing court has recently reaffirmed that:

[A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the ‘improvement’ is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal-and even common-sensical-we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.

Dystar Textilfarben GmbH v. C.H. Patrick Co., 464 F.3d 1356, 1368 (Fed. Cir. 2006). *See also Leapfrog Enters., Inc. v. Fisher-Price Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007)(holding it “obvious to combine the Bevan device with the SSR to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost.”)

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellants’ Briefs to show error in the proffered prima facie case.

We note that arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be

waived. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2006). *See also In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004).

Findings of Fact

The following findings of fact are supported by a preponderance of the evidence.

Morinaga

1. Morinaga teaches an access right control unit 124. The access right control unit checks the access right on the file and the link provided to the user and changes the status of the access right if necessary. (Col. 4, ll. 32-38).

Graham

2. Graham teaches a client module 230. The client module intercepts calls between the application and OS. If the call is not allowed it is blocked. (Para. [0118] – [0119].
3. Graham teaches that a filter driver allows the client module 230 to intercept and modify file requests. (Para. [0141]).

ANALYSIS

Claims 1-20

The cited references fail to teach or suggest suppression of a file I/O request

We consider the Examiner's rejection of independent claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Morinaga, McCurdy, and Graham. We select claim 1 as the representative claim for this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants contend that the cited references, most notably Graham, fail to teach suppression of a file I/O, as recited in claim 1. (App. Br. 4). Appellants assert that the interception and modification of the file system request disclosed in Graham is not the same as the claimed suppression of a file I/O request. (*Id.*) We disagree.

Claim Construction

During prosecution, “the PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)).

Here, when we refer to Appellants’ Specification for *context*, we find Appellants have given no special definitions to the claim terms “quashing”¹ and “suppressing” that differ from the meanings that these terms would otherwise possess, as follows:

“Otherwise, in block 212, the file I/O request can be *quashed*.” (Spec. 16, l. 19, emphasis added).

“In fact, in another aspect of the present invention, each of the *quashing*, *suppression* and decryption can occur concurrently to one another.” (Spec. 18, ll. 11-12, emphasis added).

Therefore, we find that Appellants’ Specification does not clearly redefine the terms “quashing” and “suppressing” such that one of ordinary skill in the art would deem the meanings to be different from the common meanings of these terms. “In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the

¹ See claims 5, 7, 10, 12, 17, and 19.

ordinary and customary meanings attributed to them by those of ordinary skill in the art.” *Brookhill-Wilk 1, LLC. v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003). “[T]he words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The “ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” (*Id.* at 1313).

This reasoning is applicable here. Thus, we broadly but reasonably construe the limitations of *suppressing/quashing said file I/O request* to mean that the I/O request is stopped at any point. We find Appellants’ disclosure does not support a construction where suppression/quashing means completely deleting the I/O request (*Id.*). For example, dependent claim 4 recites authenticating the file I/O request which necessarily requires “intercepting” (i.e., receiving) the request. Authentication of the file I/O request converts (i.e., modifies) an unauthenticated request to an authenticated request. Moreover, we note that the claim term “suppressing” encompasses interception, as disclosed in Appellants’ Specification: “The *suppressing* step can include . . . *intercepting* an operating system event in the authoring application” (Spec. 8, ll. 7-9, emphasis added),

Based on the above claim construction, we agree with the Examiner’s determination that Graham teaches a client module 230 that intercepts and modifies the file requests. (FF 4). As a result, we find that the original file request has been “suppressed/quashed,” because of the modification.

Appellants argue that Graham fails to teach “a complete quashing of the request as expressly claimed . . .” (Reply Br. 2). However, the independent claims do not recite “a *complete* quashing” of the I/O requests as argued by Appellants, and we decline to read this limitation into the independent claims. Thus, we find that the cited references teach and/or suggest *suppressing/quashing* (intercepting and modifying) *the I/O* (file) request, as recited in independent claims 1, 9, 12, and 13.

In response to the Examiner’s arguments, Appellants further contend that the cited references fail to teach suppressing a file I/O request followed by the automatic extraction of digital rights management data appended to the file. (Reply Br. 3). We agree.

The Examiner contends that the extraction of the digital rights was taught in Morinaga. (Ans. 5). However, we find that Morinaga merely teaches how the access rights are managed. (FF 2). We do not find nor does the Examiner establish, that Morinaga teaches that the digital rights are *extracted from the file request*, after the I/O request has been suppressed, as recited in claim 1.

We note that the limitation of extracting the digital rights management data, is similarly recited in independent claims 1, 12, and 13. However, the limitation of extracting the digital rights management data is not recited in independent claim 9. Thus, we conclude that Appellants have shown error in the Examiner’s prima facie case of obviousness regarding claims 1, 12, and 13 and the claims dependent on them. Appellants have not met their burden in showing error in the Examiner’s rejection of independent claim 9 and claims 10-11, which fall therewith.

One skilled in the art would not be motivated to combine the teachings of Morinaga and Graham

Appellants further contend that one skilled in the art would not be motivated to combine the teachings of Morinaga and Graham. (App. Br. 6). More specifically, Appellants contend that the cited combination would “destroy the operation of the Appellants’ claimed invention.” (*Id.*) We disagree.

It is our view that Appellants’ argument does not take into account what the collective teachings of the prior art would have suggested to one of ordinary skill in the art and is therefore ineffective to rebut the Examiner’s prima facie case of obviousness. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.) (citations omitted, emphasis added).

Keller, 642 F.2d at 425.

This reasoning is applicable in the present case.

As discussed *supra*, Graham teaches that the file request is suppressed/quashed as recited in the independent claims. We also found that the interception and modification of the request, as disclosed in Graham, does preclude the forwarding of the original file request. Thus, based on the record before us, we find that the Appellants have not shown error in the Examiner’s proffered motivation to combine Morinaga, McCurdy, and Graham in rejecting claims 1-20.

Independent claims 1, 12, and 13

For the reasons discussed above, we reverse the rejection of independent claims 1, 12, 13, as being unpatentable over Morinaga, McCurdy, and Graham.

Claims 2-8 and 14-20

Further, because dependent claims 2-8 depend from claim 1, and dependent claims 14-20 depend from claim 13, the rejection of these dependent claims is also reversed.

As discussed above, the rejection of claim 9, and claims 10-11 which fall therewith, is sustained.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have shown the Examiner erred in rejecting claims 1-8 and 12-20 under 35 U.S.C. § 103(a) for obviousness.

We further conclude that the Appellants have not shown that the Examiner erred in rejecting claims 9-11 under 35 U.S.C. § 103(a). Thus, claims 9-11 are not patentable.

DECISION

The decision of the Examiner rejecting claims 9-11 is affirmed. The decision of the Examiner rejecting claims 1-8 and 12-20 is reversed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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